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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,990	08/28/2002	Jurgen Lang	ACDPA-5002 PWO	3252
23416 7590 03/22/2007 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			EXAMINER FIELDS, COURTNEY D	
			ART UNIT	PAPER NUMBER
			2137	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/089,990

Applicant(s)

LANG ET AL.

Examiner

Courtney D. Fields

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-24 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-24, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 30-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-19 and 25-27 have been cancelled.
2. Claims 28-33 have been added
3. Claims 20-24 have been amended.
4. Claims 20-24 and 28-33 are pending.

### ***Priority***

5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 20,23,29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim language "digital currency depot" has been added to the claim limitations. It is impossible for the Examiner to determine the definition or meaning for the terminology which has been added to the currently amended claims, because the English translation of the 371 has not been received by the Patent and Trademark Office.

#### ***Specification***

9. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the Examiner has yet to receive an English translation with regards to the Specification.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification

contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

### ***Claim Objections***

10. Claim 22 is objected to because of the following informalities: "A method for producing a forgery-proof document, the method comprising: using the security module of claim 20"

11. The Examiner suggest the following claim language to be applied: "The method of claim 20, wherein producing a forgery-proof document comprising: a security module". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 20-24 and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Elsner (U.S. Patent No. 5,150,409).

Referring to the rejection of claims 20 and 23, Elsner discloses a security module suitable for use with a digital currency depot for producing forgery-proof documents comprising:

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an identification register (See Column 15, lines 28-33), key register (See Column 15, lines 28-33) and a secret generator that generates an unpredictable secret (See Column 15, lines 28-33)

a first combination machine arranged to combine an output value of the identification register and an output value of the secret generator (See Column 15, lines 54-58)

an encryption machine arranged to encrypt an output of the first combination machine to an authentication unit via a first outlet valve (See Column 15, lines 59-66)

a second combination machine that combines the unpredictable secret and input data received via an inlet valve (See Column 15, lines 66-68)

a hash machine that generates and outputs an irreversible hash value responsive to an output of the second combination machine (See Column 16, lines 1-7)

and means for ensuring that the forgery proof document is produced only if actual sums of money are available to the digital currency depot (See Column 15, lines 43-50)

Referring to claim 21, Elsner discloses the claimed limitation wherein at least one value stored in the key register is used by the encryption machine to provide the encrypted output of the first combination machine (See Column 16, lines 30-42)

Referring to claim 22, Elsner discloses the claimed limitation wherein producing a forgery-proof document, comprising:

using a security module (See Column 16, lines 67-68, Column 17, lines 1-3)

providing the output of the second combination machine as forgery-proof information to the forgery-proof document, (See Column 16, lines 43-51)

and issuing the forgery-proof document (See Column 17, lines 37-47)

Referring to claims 24 and 28, Elsner discloses the claimed limitation wherein the outputting the irreversible hash value to the forgery-proof document as forgery-proof information (See Column 17, lines 22-36)

Referring to claim 29, Elsner discloses the claimed limitation wherein reducing a register value associated with a particular currency sum available to the digital currency depot in response to production of the forgery-proof document (See Column 17, lines 48-63)

#### ***Allowable Subject Matter***

11. Claims 30-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*CDJ*  
cdf

March 17, 2007

*Matthew D. Smithers*  
MATTHEW SMITHERS  
PRIMARY EXAMINER  
Art Unit 2137